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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,886	11/24/1999	KAZUMASA OISHI	PM-265102	4411

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EXAMINER
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LAMB, BRENDA A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 01/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/447,886

Applicant(s)

Dishi et al

Examiner

Lamb

Group Art Unit

1734

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 9/5/01
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 3-13 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 3-5 and 10-13 is/are rejected.
- ☒ Claim(s) 6-9 is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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### DETAILED ACTION

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-4 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor.

Taylor teaches design of an optical fiber coating apparatus comprised of the following elements: a first coating die having a first die hole, a lower end face and a protrusion formed around the first die hole such that fiber traveling through the first die hole is coated by a first coating resin which is injected in the space formed between the first die hole and the outer periphery of the fiber; a second coating die having a second die hole concentric with the first die hole, an upper end face which opposes the lower end face of the first coating die so as to form a

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gap through which the second coating resin is injected into a space between the second die hole and fiber. Taylor fails to teach that the lower end face of the first die is disk shaped and upper end face of the second coating die is circular or satisfies the relationship set forth in claims 3 and 10-13. However, it would have been obvious matter of design choice to design the lower end face of the Taylor first die such that it is disk-shaped and upper end face of the Taylor second die such that it is circular or dimension of the protrusion meets the relationship set forth in above cited claims since such a modification would have involved a mere change in the shape of a component absent persuasive evidence that the particular configuration of the claimed above cited elements was significant (In re Dailey, 149 USPQ 47 (CCPA 1966)). Taylor fails to teach the protrusion reduces an annular lower-pressure region formed around the fiber in the gap. However, it would have been obvious that the Taylor protrusion would have reduced the annular lower pressure region around the fiber in the gap in order to substantially eliminate recirculation of the second coating liquid in the vicinity of the fiber and especially since the physical presence of the protrusion itself would have reduced the total area of the gap. With respect to claim 4, Taylor fails to teach the shape of protrusion is a circular truncated cone. However, it would have been an obvious matter of design choice to design the protrusion such that it is a circular truncated cone since such a modification would have involved a mere change in the shape of a component absent persuasive evidence that the particular configuration of the claimed element was significant ( In re Dailey, 149 USPQ 47 (CCPA 1966)).

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Claims 3-4 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 09241042.

Japan '042 teaches design of an optical fiber coating apparatus comprised of the following elements: a first coating die having a first die hole, a disk shaped lower end face and a protrusion formed around the first die hole such that fiber traveling through the first die hole is coated by a first coating resin which is injected in the space formed between the first die hole and the outer periphery of the fiber; a second coating die having a second die hole concentric with the first die hole, a circular upper end face which opposes the lower end face of the first coating die so as to form a gap through which the second coating resin is injected into a space between the second die hole and fiber. Japan '042 fails to teach the protrusion reduces an annular lower-pressure region formed around the fiber in the gap or satisfies the relationship set forth in claims 3 and 10-13. However, it would have been obvious that the Japan '042 protrusion would have reduced the annular lower pressure region around the fiber in the gap in order to substantially eliminate recirculation of the second coating liquid in the vicinity of the fiber and especially since the physical presence of the protrusion itself would have reduced the total area of the gap. Further, it would have been obvious matter of design choice to design the Japan '042 protrusion such that it meets the relationship set forth in above cited claims since such a modification would have involved a mere change in the shape of a component absent persuasive evidence that the particular configuration of the claimed element was significant (In re Dailey, 149 USPQ 47 (CCPA 1966)). With respect to claim 4, Japan '042 fails to teach the protrusion has the shape of a circular

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truncated cone shape. However, it would have been an obvious matter of design choice to design the Japan '042 protrusion such that it is a circular truncated cone since such a modification would have involved a mere change in the shape of a component absent persuasive evidence that the particular configuration of the claimed element was significant (In re Dailey, 149 USPQ 47 (CCPA 1966)).

Applicant's arguments filed 9/5/01 have been fully considered but they are not persuasive.

Applicant's argument that Taylor nor Japan 09241042 teach or suggest that the apparatus satisfy the relationship of  $0.05 G < H < 0.5G$  which provided for suppression of the outside diameter fluctuation of the coating is found to be non-persuasive. The specification at page 22-23 and the Table on page 21 appear to suggest that the combination of relationships set forth at lines 5-7 of page 23 must be met to provide for the suppression of the outside diameter fluctuation and not a selected one of the relationships set forth at lines 5-7 of page 23 such as above cited relationship of  $0.05 G < H < 0.5G$  as argued by applicant. Therefore, it would have been an obvious matter of design choice to design the lower end face of the Taylor first die such that it is disk-shaped and upper end face of the second die such that it is circular or satisfies the relationship set forth in claims 3 and 10-13 since such a modification would have involve a mere change in the shape of a component absent persuasive evidence that the particular configuration of the claimed above cited elements was significant ( In re Dailey, 149 USPQ 47 ( CCPA 1966)).

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Claims 5 and 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "said circular truncated cone" in claims 10-13 lack proper antecedent basis. The term "the head portion" in claims 5, 11 and 13 lack proper antecedent basis.

Claims 6-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 5 is would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication should be directed to Brenda Adele Lamb at telephone number (703) 308-2056.

  
BRENDA A. LAMB  
PRIMARY EXAMINER  
GROUP 1300

Lamb/af

January 3, 2002